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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Filing Date: 04/27/93
Appellant(s): Jean M. Clement

95-4596

Jean M. Clement
For Appellant

EXAMINER'S ANSWER

MAY 12 1995

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BOARD OF PATENT APPEALS
AND INTERFERENCES

This is in response to appellant's brief on appeal filed 4-3-95.

(1) *Status of claims.*

The statement of the status of claims contained in the brief is correct.

This appeal involves claims 1-18 and 49-52.

(2) *Status of Amendments After Final.*

No amendment after final has been filed.

(3) *Summary of invention.*

The summary of invention contained in the brief is correct.

(4) *Issues.*

The appellant's statement of the issues in the brief is

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correct.

Note the objection to the specification made in the final Office action, while not an appealable issue, is still maintained.

(5) *Grouping of claims.*

The rejection of claims 49-52 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(5).

The rejection of claims 1-18 and 49-52 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(5).

(6) *Claims appealed.*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(7) *Prior Art of record.*

No prior art are relied upon by the examiner in the rejection of claims under appeal.

(8) *New prior art.*

No new prior art has been applied in this examiner's answer.

(9) *Grounds of rejection.*

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The following ground(s) of rejection are applicable to the appealed claims.

Claims 49-52 are rejected under 35 U.S.C. § 251 as being broadened in a reissue application filed outside the two year statutory period.

New claim 49 is broader than the patent claims in many respects; for example, claim 49

- 1) fails to specify "at room temperature in step (b)
- 2) fails to claim mechanical energy levels of steps (a) and (c) (1) and (c) (2)
- 3) fails to claim temperature range - (c) (1) and (c) (2)
- 4) fails to claim alkaline pH of at least 9 (c) (1) and (c) (2).

This broadening reissue is considered not to be timely filed since the parent reissue, SN. 07/600,012, was not a broadening reissue - SN 600,012 lacked basis for reissue because it was not for the invention disclosed in the original patent. Thus applicant cannot rely upon the filing date of SN 600,012 as being a broadening reissue filed within the two year statutory period. Also it is noted that by applicant's own admission in the oath, he did not discover this "error" until April 1993 - almost 5 years after the patent issued.

Claims 1-18 and 49-52 are rejected as being based upon a defective reissue declaration under 35 USC 251. See 37 CFR 1.175. (Note this rejection was inadvertently not explicitly made, in the Final action, but it is not considered to be a new ground of rejection since it merely relies on the defects of the reissue oath which were set forth in detail in the final Office action).

The reissue oath or declaration filed with this application is defective because it fails to particularly specify the errors relied upon, as required under 37 C.F.R. § 1.175(a)(5).

The reissue oath or declaration filed with this application is defective because it fails to particularly specify how the errors relied upon arose or occurred, as required under 37 C.F.R. § 1.175(a)(5).

The errors set forth by applicant are not errors correctable by reissue since applicant is attempting to recapture claimed subject matter deliberately narrowed by applicant during original prosecution in order to obtain the patent. See MPEP 1412.02 and Mentor Corp v. Coloplast Inc. CAFC 27 USPQ 2d 1521. Applicant during original prosecution, narrowed the claims to set forth specific mechanical energy levels, room temperature cleaning, and alkaline pH of at least 9 in order to overcome rejections made in

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that case. Applicant cannot now call these errors. It is not correctable by reissue. (applicant could have filed a continuation application to pursue claims of broader scope than those allowed in the original prosecution.) Note page 3 of the reply brief filed 6-1-92 in SN 600,012 even admits that the very specific process parameters of claim 1 were added during original prosecution in order to distinguish over the prior art.

Further the oath does not specify each change from the original patent claims as an error and how/why each error arose/occurred. Applicant fails, for example only, to discuss why specifying "at room temperature" for step (b) was an error. Each change represents acknowledgement of an error and must be referred to in the declaration. MPEP 1414, 1444.

Further, it does not seem that applicant can properly claim miscommunication difficulties because of his limited understanding of U.S. patent law as a reason for how the errors occurred. A lapse of almost five years from issuance of the original patent until applicant finally met and had "detailed review" of this situation with the attorneys of record in this case does not appear to be sufficient basis for how/why the errors arose which are the basis for reissue in this case.

Claims 1-18 and 49-52 are rejected under 35 USC 251 as

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lacking basis for reissue, since recapture is not an error correctable by reissue. See above. Also, as stated in Hewlett Packard v Bausch & Lomb 11 USPQ 2d 1758, "reissue is not intended to give the patentee simply in second chance to prosecute the patent application... Section 251 does not authorize a patentee to re-present his application. Insight resulting from hindsight on the part of new counsel does not, in every case, establish error".

(10) *New ground of rejection.*

This Examiner's Answer does not contain any new ground of rejection.

(11) *Response to argument.*

Applicant argues that parent case SN 600,012 was a "broadening" reissue. The examiner disagrees. The examiner's position is that the parent reissue SN 600,012 lacked basis for reissue.

The claims 19-48 of SN 600,012 were not for the invention disclosed and claimed in the original patent. In re Rowland 187 USPQ 487, Reissue applicants failure to timely file a divisional application is not considered to be an error causing a patent granted on elected claims to be partially inoperative by reason claiming less than they had a right to claim, thus applicants

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error is not correctable by reissue of the original patent under 35 USC 251 - See In re Orita et al 193 USPQ 145 In re Mead 198 USPQ 412.

In the original patent, restriction was required and applicant canceled the claims drawn to the invention of reissue claims 19-48. No matter what "communication difficulties and misunderstandings" applicant had with his attorneys, this situation was not correctable by reissue.

Paper No. 2 of grandparent 06/482,623 set forth in the original restriction requirements, paper no. 5 elected group 1 without traverse. The basis for the original restriction requirement was that the two groups recited mutually exclusive processing conditions. The examiners position is that the new claims 19-48 of SN 600,012 likewise recite mutually exclusive processing conditions from allowed claims 1-18 and were thus still properly restrictable.

New claims 19-48 of parent 600,012 did not require any specific temperatures, pH's, shear forces (power inputs), consistencies, brightness, etc. Merely reciting high temperatures, high shear forces is not adequate to make these claims drawn to the same invention as patent claims 1-18. (Note "high" is relative and thus indefinite in any event). Thus

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claims 1-18 of 600,012 (Group I) require use of specific temperatures, power inputs, time limits, pHs, consistencies, brightness values, etc. processing conditions while claims 19-48 (Group II) do not require these conditions but do require steps of producing two pulps, recycle, etc. that are not required by Group I. Thus the two Groups are clearly drawn to mutually exclusive processing conditions, and are properly restrictable from one another. This situation cannot be corrected by reissue.

Thus SN 600,012 cannot be considered to have been a broadening reissue filed within two years. It is of no moment if claims 19-48 of 600,012 were disclosed in the '179 patent. The claims 19-48 of 600,012 lacked basis for reissue. The case law cited by applicant on pages 2, 3 of their remarks in Paper No 3 and pages 7, 8 of their brief do not address this specific situation, where a parent reissue is an improper reissue, which clearly lacks an/error correctable by reissue.

Appellant argues it is inconsistent for the examiners to state that parent case SN 600,012 claims 19-48 were not disclosed in '179 patent, then state ~~it~~ is of no moment if they were disclosed in '179 patent.

The examiner apologizes for any confusion, but the examiners position remains that since the claims 19-48 of SN 600,012 lacked

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basis for reissue because failure of timely file a divisional application is not considered to be error correctable by reissue, then SN 600,012 cannot be considered a broadening reissue filed within two years. Of course these claims were "disclosed" in '179 specification - similar claims ^{were} restricted. However the case law is clear that in this situation, failure to file a divisional is not an error for reissue.

Appellant argues the recapture rule does not apply because there is no evidence that the amendments were in any sence an admission that the scope of the claims was not patentable. This argument is not persuasive because applicant even admitted that the very specific process parameters of claim 1 were added during original prosecution in order to distinguish over the prior art (page 3 of reply brief filed 6-1-92 in SN 600,012).

In any event, the claims also are rejected since they are broadening the scope of the original claims outside the two year limit prescribed by 35 USC 251. Appellants cannot rely on the filing date of SN 600,012 for the reasons set forth above.

Appellant argues the reissue declaration properly specifies the errors and how they occurred.

The examiner disagrees. MPEP 1444 clearly states "Every departure from the original patent represents an error in the

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original patent... and must be positively and distinctly specified and supported in the reissue oath." This appellant simply has not done.

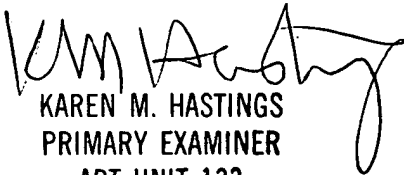
Furthermore, the "miscommunication difficulties" are generally conclusions, not facts, and provide no useful information with respect to determining any specific errors as a result of a misunderstanding. As stated above, a lapse of almost five years from issuance of the patent until applicant finally met and had a "detailed review" of this situation with the attorneys appears "prima facie" to not be a sufficient basis for how/why errors arose. This five year lapse also appears to support the examiner's position that this case improperly broadens claims after the two year limit prescribed by 35 USC 251.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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May 10, 1995

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